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Docket No.: 249768020US1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Amit D. Agarwal

Application No.: 09/558,313

Confirmation No.: 9641

Filed: April 25, 2000

Art Unit: 3627

For: AUTOMATICALLY INITIATING PRODUCT
REPLENISHMENT

Examiner: Ronald Laneau

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is in furtherance of the Notice of Appeal filed in this case on February 18, 2005. The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

I. REAL PARTY IN INTEREST

The rights of the inventor in this application have been assigned to Amazon.com, Inc., of Seattle, Washington, as recorded at reel 010749, frame 0593.

II. RELATED APPEALS AND INTERFERENCES

Neither Appellant, Appellant's legal representative, nor the above-identified Assignee are aware of other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal.

III. STATUS OF CLAIMS

Claims 1-47 have been presented, are presently pending, and stand finally rejected.¹

The Examiner rejected claims 1-26 under the judicially created doctrine of obviousness-type double patenting over claims 1-26 of U.S. Patent No. 5,960,411 to Hartman et al. ("Hartman") in view of U.S. Patent No. 6,026,3762 to Kenney ("Kenney").

The Examiner rejected claims 1-26 under 35 U.S.C. § 103(a) over Kenney in view of *Amazon.com, Inc. v. BarnesAndNoble.com, Inc.*, 239 F.3d 1343, 57 USPQ 1747 (Fed. cir. 2001) ("Amazon").

The Examiner rejected claims 36-38 and 41-43 under 35 U.S.C. § 103(a) over Kenney.

The Examiner rejected claims 27-35 and 45-47 under 35 U.S.C. § 103(a) over Kenney in view of U.S. Patent No. 6,272,532 to Feinleib ("Feinleib").

The Examiner rejected claims 39 and 40 under 35 U.S.C. § 103(a) over Kenney in view of U.S. Patent No. 6,249,774 to Roden et al. ("Roden").

Appellants hereby appeal the rejection of claims 1-47.

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final Office Action dated October 19, 2004.

¹ The claims are shown in Appendix A.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The rejected claims are directed to techniques for automatically initiating the replenishment of items such as consumable physical products. These techniques establish a date on which an item presently being used by a consumer should probably be replenished. In some cases, these techniques establish the date based upon the identity of the item. In some cases, the techniques autonomously send a replenishment recommendation to the consumer through such communication channels as electronic mail, instant messaging, or voicemail. In some cases, the techniques provide a replenishment recommendation containing a control that the consumer may, with a single action, use to request replenishment of the item. In some cases, the techniques, when they determine that the item should be replenished, automatically cause the item to be replenished, without requiring any action of the consumer.

In at least one embodiment, a software facility automatically initiates the replenishment of a consumable product by fulfilling an order by a consumer for a first instance of the product on a first date. Based upon the first date, the facility estimates a second date by which the first instance of the product will be fully consumed, and, before the second date, provides to the consumer an indication that the product should be replenished. (This finds support in the specification, for example, at page 3, lines 6-11.) The indication includes a control that is usable by the consumer to request replenishment of the product by performing a single action. (See specification, page 3, lines 11-13 and page 6, lines 3-10.) The facility receives an indication that the control was used by the consumer to request replenishment of the product and, in response solely to receiving this indication, orders a second instance of the product to replenish the first instance of the product. (See specification, page 3, lines 13-15.)

In at least one embodiment, a software facility fulfills an order by a consumer for a first item on a first date, and determines a target date for suggesting replenishment of the first item based upon the first date and the identity of the first item. On the target date, the facility provides to the consumer an indication that the first item should be replenished.

(See specification, page 3, lines 6-11.) The indication includes a user interface control that is usable by the consumer to request replenishment of the first item. (See specification, page 3, lines 11-13 and page 6, lines 3-10.) The facility receives an indication that the control was used by the consumer to request replenishment of the first item and, in response solely to receiving this indication, orders a second item to replenish the first item. (See specification, page 3, lines 13-15.)

In at least one embodiment, a computer-readable medium's contents cause a computing system to receive an indication of an order by a consumer for a first item having a first date. The contents cause the computing system to determine a target date based upon the identity of the first item and, on the target date, provide to the consumer an indication that the first item should be replenished. (See specification, page 3, lines 6-11.) The indication includes a user interface control that is usable by the consumer to request replenishment of the first item. (See specification, page 3, lines 11-13 and page 6, lines 3-10.) The contents cause the computing system to receive an indication that the control was used by the consumer to request replenishment of the first item and, in response solely to receiving this indication, order a second item to replenish the first item. (See specification, page 3, lines 13-15.)

In at least one embodiment, a method for assessing item replenishment determines that a purchasing entity possesses an item and determines an expiration time for the item. The method schedules for a time preceding the determined expiration time a unilateral transmission of a communication to the purchasing entity indicating that the item should be replenished. (See specification, page 4, lines 1-16 and page 5, lines 23-30.)

In at least one embodiment, a computer-readable medium's contents cause a data processing system to determine that a purchasing entity is using an item and determine an expiration time for the item. The contents cause a data processing system to schedule for a time preceding the determined expiration time a unilateral transmission of a

communication to the purchasing entity indicating that the item should be replenished. (See specification, page 4, lines 1-16 and page 5, lines 23-30.)

In at least one embodiment, a system for automatic item replenishment comprises a replenishment targeting subsystem, a replenishment proposal subsystem, and a replenishment ordering subsystem. The replenishment targeting subsystem determines a target date for replenishment of an item purchased by a purchaser on a purchase date. The replenishment proposal subsystem transmits to the purchaser in advance of the target date, at a time at which the purchaser is not engaged in an electronic shopping activity, a replenishment proposal to order replenishment for the item. The replenishment ordering subsystem orders a replacement for the item in response to an affirmative response to the replenishment proposal from the purchaser. (See specification, page 3, lines 6-21 and page 5, lines 3-21.)

In at least one embodiment, a computer memory contains an item replenishment data structure comprising a plurality of entries. Each of the entries comprises an identification of a consumer, an identification of an item, and an indication of a target date on which the replenishment of the item is to be proposed, such that, on a current date, for each entry indicating the current date as its target date, a unilateral communication can be transmitted to the consumer identified by the entry proposing the replenishment of the item identified by the entry. (See specification, page 6, line 24-page 7, line 6 and page 7, line 24-page 8, line 5.)

In at least one embodiment, a data signal conveys an item replenishment data structure comprising a plurality of entries. Each of the entries comprises an identification of a consumer, an identification of an item, and an indication of a target date on which the replenishment of the item is to be proposed, such that, on a current date, for each entry indicating the current date as its target date, a unilateral communication can be transmitted to the consumer identified by the entry proposing the replenishment of the item identified

by the entry. (See specification, page 6, line 24-page 7, line 6 and page 7, line 24-page 8, line 5.)

In at least one embodiment, a method for automatically replenishing an item determines that a consumer is using an item and determines a target date for replenishing the item. The method, without intervention by the consumer, places an order on the consumer's behalf for replenishment of the item within a predetermined tolerance of the target replenishment date. (See specification, page 8, line 28-page 9, line 3.)

In at least one embodiment, a method for suggesting item replenishment determines that a purchasing entity is using an item. The method establishes a condition for suggesting replenishment of the item, and tests the condition. When testing indicates that the condition is satisfied, the method raises an event and, when the event is raised, unilaterally suggests replenishment of the item to the purchasing entity. (See specification, page 7, line 24-page 8, line 22.)

In this manner, the embodiments of Appellant's techniques anticipate the consumer's need to replenish a product, and provide a convenient way for the consumer to replenish the product.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. Is the rejection of claims 1-26 under the judicially created doctrine of obviousness-type double patenting over claims 1-26 of Hartman in view of Kenney proper?
- B. Is the rejection of claims 1-26 under 35 U.S.C. § 103(a) over Kenney in view of Amazon proper?
- C. Is the rejection of claims 36-38 and 41-43 under 35 U.S.C. § 103(a) over Kenney proper?

- D. Is the rejection of claims 27-35 and 45-47 under 35 U.S.C. § 103(a) over Kenney in view of Feinleib proper?
- E. Is the rejection of claims 39 and 40 under 35 U.S.C. § 103(a) over Kenney in view of Roden proper?

VII. ARGUMENT

- A. The Rejection of Claims 1-26 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting Over Claims 1-26 of Hartman In View of Kenney Is Improper

1. Legal Requirements for Obviousness-Type Double Patenting

In re Braat., 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991) provides:

Obviousness-type double patenting is a judicially created doctrine intended to prevent improper timewise extension of the patent right by prohibiting the issuance of claims in a second patent which are not "patentably distinct" from the claims of the first patent. . . . The doctrine has also been phrased as prohibiting claims in the second patent which define "merely an obvious variation" of an invention claimed in the first patent.

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat.*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed Cir. 1985).

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is: Does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? MPEP § 804(II)(B)(1).

2. Hartman

Hartman is assigned to Amazon.com, Inc., of Seattle, Washington, as is the present application, and is directed to single-action ordering of items in a client-server environment. (col. 3, lines 31-33.)

3. Kenney

Kenney is directed to an approach to enabling the reordering of items *while the shopper is shopping at a shopping website*. In Kenney, the shopper first creates a list of items that may later be reordered, called a reorder list. (col. 11, lines 21-24.) When the shopper is later shopping, the shopper can display the items in the reorder list, and select items from the reorder list to be added to a current list. (col. 11, lines 13-15.) The shopper may also enter new items into the current list. (col. 11, line 15.) When the shopper finishes shopping, the user controls his or her local computer to automatically organize the items in the current list, and print it if desired. (col. 11, lines 15-20.)

4. The Examiner Failed to Show that Claims 1-26 Define an Invention that is Merely an Obvious Variation of Claims 1-26 of Hartman

In a fourth Office Action dated January 30, 2004, the Examiner rejected claims 1-26 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of Hartman in view of Kenney. Regarding claim 1, the Examiner states in this Office Action that:

Claim 1 of Hartman claims the step of "in response to only a single action being performed, sending a request to order the item". Hartman does not teach the steps of automatically initiating the replenishment of a consumable product. Kenney teaches a method in a data processing system for automatically initiating the replenishment of a consumable product comprising the steps of receiving an order for a customer and filling that order on a first date and estimating a target date for suggesting replenishment (col. 11, lines 12-34). The user is provided with an indication that the product should be replenished (see Figures 5 and 7 and col. 12, lines 50-54). The consumer then requests replenishment of

the product by performing an interaction, and the product is ordered (Fig. 10A). The target date is estimated based on the first date and the average life span of the item, which in turn is determined by the length of intervals between purchases (col. 11, lines 26-34). It is inherent that Kenney employs a computer memory and a computer-readable medium containing instructions for carrying out the method.

(fourth Office Action, pp. 2-3.)

The Examiner has failed to show how claims 1-26 define an invention that is merely an obvious variation of claims 1-26 of Hartman. Claim 1 recites "before the second date, providing to the consumer an indication that the product should be replenished, *the indication including a control usable by the consumer to request replenishment of the product by performing a single action.*" (emphasis added.) Claims 2-26 each recite "on the target date, providing to the consumer an indication that the first item should be replenished, *the indication including a user interface control usable by the consumer to request replenishment of the first item.*" (emphasis added.) In a fifth Office Action dated October 19, 2004, the Examiner responds to Appellant's argument that the Examiner has failed to identify how Kenney either discloses or suggests providing a replenishment indication that the product should be replenished, where the indication includes a user interface control usable by the consumer to request replenishment of the product by performing a single action, with the following statement:

Applicant's arguments about the Double Patenting Rejection are not persuasive. The rejection is proper because Hartman teaches all the claimed limitations except the steps of "automatically initiating the replenishment of a consumable product" then Kenney is used to teach the "automatically initiating the replenishment of a product" [sic] Applicant further argues that Examiner has failed to identify how Kenney either discloses or suggests providing a replenishment indication including such a user interface control as part of the replenishment indication. The Examiner's position is that the local computer (20a . . . 20n) can be used by a user to request that replenishment in the form of an email message as argued.

(fifth Office Action, p. 8.)

With respect to claims 1-26, these statements do not satisfy the Examiner's burden of showing how claims 1-26 define an invention that is merely an obvious variation of claims 1-26 of Hartman. Contrary to the Examiner's position, using a local computer to request replenishment in the form of an email message does not disclose or suggest a replenishment indication that includes a control usable by the consumer to request replenishment of the product, as recited in Appellant's claims 1-26. For example, the [replenishment] indication may be in the form of an email message (See specification, page 6, lines 3-5), and included in this email message [replenishment] indication is a control, such as a user interface control, that may be used to request replenishment of the product (See specification, page 6, lines 16-19). A local computer used by a user to request that replenishment in the form of an email message, as suggested by the Examiner, is not a [replenishment] indication that includes a control that is usable by the consumer to request replenishment of the product, as recited. Stated differently, a user requesting replenishment by sending an email message does not disclose or suggest using a control that is included in a replenishment indication to request replenishment of the product. Accordingly, the Examiner has failed to satisfy his burden with respect to these claims.

5. Hartman and Kenney Together Fail to Disclose or Suggest All of the Elements Recited by Claims 1-26, and are Therefore Incapable of Supporting any Obviousness-Type Double Patenting Rejection

Together, Hartman and Kenney fail to disclose or suggest all of the elements recited by claims 1-26. Claim 1 recites "before the second date, providing to the consumer an indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action." Claims 2-26 each recite "on the target date, providing to the consumer an indication that the first item should be replenished, the indication including a user interface control usable by the consumer to request replenishment of the first item." As discussed above, both Hartman and Kenney fail to disclose or suggest providing a replenishment indication that

includes a user interface control usable by the consumer to request replenishment of the product by performing a single action as part of the replenishment indication. Kenney merely states that products may be distinctively displayed to indicate to the shopper that the displayed products need to be reordered. (col. 12, lines 50-54.) As can be seen in Figs. 5 and 7, Kenney's indication does not include a control that may be used to request replenishment of the product. For at least these reasons, Kaplan, Hartman and Kenney cannot support any obviousness-type double patenting rejection of these claims.

B. The Rejection of Claim 1-26 and 44 Under 35 U.S.C. § 103(a) Over Kenney In View of Amazon Is Improper

1. Legal Requirements for Obviousness

35 U.S.C. § 103(a) provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

To reject claims as being obvious, "the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). "*A prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *Id.* (quoting *In re Bell*, 991 F.2d 781, 782 (Fed. Cir. 1993)). The

Examiner is not allowed to use hindsight gleaned from the invention itself to modify references. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-51 (Fed. Cir. 1988). Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (emphasis added). The Federal Circuit emphasized this point by stating that:

[a]lthough a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.

In re Chu, 66 F.3d 262, 298 (Fed. Cir. 1995) (emphasis added).

2. Amazon

In Amazon, patentee (Amazon.com, Inc.) brought action against a competitor (Barnesandnoble.com, Inc.) alleging infringement of its U.S. Patent No. 5,960,411 and seeking a preliminary injunction. In its holding, the Court, while noting that the patentee has carried its burden with respect to demonstrating the likelihood of success on infringement, vacated the preliminary injunction granted by the lower district court and remanded the case for further proceedings.

3. The Examiner Failed to Establish a *Prima Facie* Case of Obviousness

In both the fourth and fifth Office Actions, the Examiner rejected claims 1-26 under 35 U.S.C. § 103(a) as being obvious over Kenney in view of Amazon. In rejecting the claims, the Examiner states in both Office Actions that:

Kenney discloses a method in a data processing system for automatically initiating the replenishment of a consumable product comprising the steps of receiving an order for a customer and filling that order on a first date

and estimating a target date for suggesting replenishment (col. 11, lines 12-34). The user is provided with an indication that the product should be replenished (see Figures 5 and 7 and col. 12, lines 50-54). The consumer then requests replenishment of the product by performing an interaction, and the product is ordered (Fig. 10A). The target date is estimated based on the first date and the average life span of the item, which in turn is determined by the length of intervals between purchases (col. 11, lines 26-34). It is inherent that Kenney employs a computer memory and a computer-readable medium containing instructions for carrying out the method.

(fourth Office Action, pp. 4-5; fifth Office Action, pp. 4-5.)

The Examiner has failed to establish a *prima facie* case for the obviousness rejection of claims 1-26 over Kenney in view of Amazon, in that the Examiner has failed to show how the teachings from Kenney and Amazon would have suggested the subject matter claimed in claims 1-26 to a person of ordinary skill in the art.

Claims 1 and 44 each recite "before the second date, providing to the consumer an indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action." The Examiner has failed to point out where and how the combination of Kenney and Amazon suggests the cited feature of claims 1 and 44. Kenney merely states that products may be distinctively displayed to indicate to the shopper that the displayed products need to be reordered. (col. 12, lines 50-54.) According to Figs. 5 and 7, Kenney's indication does not include a control that may be used to request replenishment of the product. Moreover, Kenney makes clear that the user must select reorder items from a reorder list, enter new items to be selected, and control his or her computer to automatically organize his or her current list. (col. 11, lines 13-34.) Because these interactions amount to significantly more than the single action recited, Kenney fails to disclose or suggest this feature recited by claims 1 and 44. The Examiner has failed to show how the teachings from Kenney and Amazon would have suggested providing a replenishment indication that includes a user interface control usable by the consumer to

request replenishment of the product by performing a single action as part of the replenishment indication.

Claims 2-26 each recite "determining a target date for suggesting replenishment of the first item, the target date based upon the first date and the identity of the first item." The Examiner has failed to point out where and how the combination of Kenney and Amazon suggests the cited feature of claims 2-26. The only determination of a possibly analogous target date disclosed or suggested by Kenney is automatically computing an average time between purchases for each product. (col. 11, lines 28-34.) Such processing completely fails to take into account the identity of each product, as recited by these claims. The Examiner has failed to show how the teachings from Kenney and Amazon would have suggested determining a target date for suggesting replenishment of the first item, where the target date is based upon the first date and the identity of the first item.

Claims 2-26 each also recite "on the target date, providing to the consumer an indication that the first item should be replenished, the indication including a user interface control usable by the consumer to request replenishment of the first item." The Examiner has failed to point out where and how the combination of Kenney and Amazon suggests the cited feature of claims 2-26. To the contrary, as discussed above in conjunction with claim 1, Kenney's indication does not include a control that may be used to request replenishment of the product. (Figs. 5 and 7). The Examiner has failed to show how the teachings from Kenney and Amazon would have suggested providing a replenishment indication that includes a user interface control usable by the consumer to request replenishment of the item as part of the replenishment indication.

Accordingly, the Examiner has failed to satisfy his burden with respect to claims 1-26 and 44.

4. Kenney and Amazon Together Fail to Disclose or Suggest All of the Elements Recited by Claims 1-26 and 44, and are Therefore Incapable of Supporting any Proper Rejection Under 35 U.S.C. § 103(a)

Together, Kenney and Amazon fail to disclose or suggest all of the elements recited by claims 1-26 and 44. Claims 1 and 44 recite "before the second date, providing to the consumer an indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action." As discussed above, Kenney does not disclose or suggest providing a replenishment indication that includes a user interface control usable by the consumer to request replenishment of the product by performing a single action as part of the replenishment indication. Amazon fails to disclose or suggest a replenishment indication and, thus, fails to cure these shortcomings of Kenney. For at least this reason, Kenney and Amazon cannot render these claims obvious.

Claims 2-26 recite "determining a target date for suggesting replenishment of the first item, the target date based upon the first date and the identity of the first item," and "on the target date, providing to the consumer an indication that the first item should be replenished, the indication including a user interface control usable by the consumer to request replenishment of the first item." As discussed above, Kenney discloses or suggests neither determining a target date in this manner, nor providing a replenishment indication that includes a user interface control usable by the consumer to request replenishment of the item as part of the replenishment indication. Amazon fails to disclose or suggest a replenishment indication and, thus, fails to cure these shortcomings of Kenney. For at least this reason, Kenney and Amazon cannot render these claims obvious.

C. The Rejection of Claims 36-38 and 41-43 Under 35 U.S.C. § 103(a) Over Kenney Is Improper

1. The Examiner Failed to Establish a *Prima Facie* Case of Obviousness

In both the fourth and fifth Office Actions, the Examiner rejected claims 36-38 and 41-43 under 35 U.S.C. § 103(a) as being obvious over Kenney. In rejecting the claims, the Examiner states in both Office Actions that:

Kenney teaches a data processing system for automatically initiating the replenishment of a consumable product comprising: receiving an order for a customer and filling that order on a first date and estimating a target date for suggesting replenishment (col. 11, lines 12-34). The user is provided with an indication that the product should be replenished (see Figures 5 and 7 and col. 12, lines 50-54). A reorder date is estimated based on the first date and the average life span of the item, which in turn is determined by the length of intervals between purchases (col. 11, lines 26-34). It is inherent that Kenney employs a computer memory, data structures, and a computer-readable medium containing instructions for carrying out the method.

Kenney does not teach the step of storing a target date on which the replenishment of the item is to be proposed. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of storing a target date for proposing replenishment of the item to ensure that the consumer is notified when the item needs to be replenished.

(fourth Office Action, pp. 6-7; fifth Office Action, pp. 6-7.)

The Examiner has failed to establish a *prima facie* case for the obviousness rejection of claims 36-38 and 41-43 over Kenney, in that the Examiner has failed to show how the teachings from Kenney would have suggested the subject matter claimed in claims 36-38 and 41-43 to a person of ordinary skill in the art.

Claims 36 and 37 each recite "on a current date, for each entry indicating the current date as its target date, a unilateral communication can be transmitted to the consumer identified by the entry proposing the replenishment of the item identified by the entry." Claim 38 recites "on a current date, for an entry indicating the current date as its

target date, a unilateral communication can be transmitted to the consumer identified by the entry proposing the replenishment of the item identified by the entry." The Examiner has failed to point out where and how Kenney suggests the cited feature of claims 36-38. To the contrary, Kenney describes waiting until the shopper returns to the shopping website before providing anything that could be said to be an indication that an item should be replenished. (col. 11, lines 8-12.) The Examiner has failed to show how the teachings from Kenney would have suggested the unilateral communication proposing the replenishment of the item.

Claims 36-38 each also recite a "data structure comprising a plurality of entries, each entry comprising an identification of a consumer, an identification of an item, and an indication of a target date on which the replenishment of the item is to be proposed." The Examiner has failed to point out where and how Kenney suggests the use of such a data structure. In the fourth Office Action, the Examiner responds to Appellant's argument that the Examiner has failed to identify how Kenney either inherently discloses or suggests such a data structure, by merely stating:

Regarding claims 36-38, Applicant argues that it is not inherent that Kenney uses a data structure comprising a plurality of entries. Examiner respectfully disagrees, and maintains that data structures are inherent to the teachings of Kenney.

(fourth Office Action, p. 8.)

This statement does not satisfy the Examiner's burden to show how Kenney would have suggested the data structure comprising entries for an identification of a consumer, an identification of an item, and an indication of a target date on which the replenishment of the item is to be proposed. The doctrine of inherent disclosure requires a showing that, though a claim element is not disclosed explicitly, it is *necessarily* included in a system as described by the explicit disclosure. *In re Robertson*, 169 F.2d 743, 745 (Fed. Cir. 1999). That is, the system *could not work* as described by the explicit disclosure were the claim element not included in the system. This is not the case in Kenney. Once a consumer

order is placed in Kenney for an item selected by the user from a reorder list, there would be no utility in storing a target date on which the replenishment of the item is to be proposed in a data structure representing the order, as this information is not needed to fulfill the order. Accordingly, the system described in Kenney could function properly without storing replenishment target dates in entries, each corresponding to a consumer order, as recited. Moreover, Kenney at no point discusses determining a target date on which the replenishment of the item is to be proposed. Rather, the extent to which Kenney facilitates proposing a replenishment of an item is permitting the user to select the item to store in a reorder list, in which at all subsequent times the item appears. Accordingly, the Examiner has failed to show how the teachings from Kenney would have suggested the data structure comprising entries for an identification of a consumer, an identification of an item, and an indication of a target date on which the replenishment of the item is to be proposed.

Claims 41-43 each recite "when testing [a condition for suggesting replenishment of the item] indicates that the condition is satisfied, raising an event," and "when the event is raised, unilaterally suggesting replenishment of the item to the purchasing entity." The Examiner has failed to point out where and how Kenney suggests raising such an event and using the event as a condition for unilaterally suggesting replenishment of the item to the purchasing entity. In a third Office Action dated June 10, 2003, the Examiner responds to Appellant's argument that the Examiner has failed to identify how Kenney either discloses or suggests raising such an event, by merely stating:

Applicant also argues that Kenney does not disclose the step of raising an event. Examiner maintains that it is inherent that an event is raised when the condition is satisfied for notifying the customer.

(third Office Action, p. 6.)

This statement does not satisfy the Examiner's burden to show how Kenney would have suggested raising such an event and using the event as a condition for unilaterally suggesting replenishment of the item to the purchasing entity. Contrary to the

requirements of the doctrine of inherent disclosure discussed above, the system described in Kenney can distinctively display products to indicate to the shopper that the displayed products need to be reordered (col. 12, lines 50-54) without testing a condition for suggesting the replenishment of the item or raising an event to indicate that the condition is satisfied. The Examiner has failed to show how the teachings from Kenney would have suggested raising such an event and using the event as a condition for unilaterally suggesting replenishment of the item to the purchasing entity.

Accordingly, the Examiner has failed to satisfy his burden with respect to claims 36-38 and 41-43.

2. Kenney Fails to Disclose or Suggest All of the Elements Recited by Claims 36-38 and 41-43, and is Therefore Incapable of Supporting any Proper Rejection Under 35 U.S.C. § 103(a)

Kenney fails to disclose or suggest all of the elements recited by claims 36-38 and 41-43. Claims 36 and 37 recite "on a current date, for each entry indicating the current date as its target date, a unilateral communication can be transmitted to the consumer identified by the entry proposing the replenishment of the item identified by the entry." Claim 38 recites "on a current date, for an entry indicating the current date as its target date, a unilateral communication can be transmitted to the consumer identified by the entry proposing the replenishment of the item identified by the entry." As discussed above, Kenney does not disclose or suggest the unilateral communication proposing the replenishment of the item. To the contrary, Kenney describes waiting until the shopper returns to the shopping website before providing anything that could be said to be an indication that an item should be replenished. (col. 11, lines 8-12.)

Claims 36-38 also recite a "data structure comprising a plurality of entries, each entry comprising an identification of a consumer, an identification of an item, and an indication of a target date on which the replenishment of the item is to be proposed." As discussed above, Kenney does not disclose or suggest such a data structure. While

Kenney may describe stored lists of items that may be replenished, it is clear from Kenney that these lists are stored separately for each shopper. There is no indication in Kenney that, in a data structure for transmitting communications to consumers proposing item replenishment, the identity of the shopper is stored along with each item in the shopper's reorder list. Doing so would be pointless, and, indeed, wasteful, as all of the items in each reorder list are associated with a single shopper. For at least these reasons, Kenney cannot render these claims obvious.

Claims 41-43 recite "when testing [a condition for suggesting replenishment of the item] indicates that the condition is satisfied, raising an event," and "when the event is raised, unilaterally suggesting replenishment of the item to the purchasing entity." As discussed above, Kenney discloses or suggests neither such an event, nor using the event as a condition for unilaterally suggesting replenishment of the item to the purchasing entity. There appears to be no mention whatsoever in Kenney of using such event-driven techniques. To the contrary, Kenney appears to describe exclusively procedural techniques that perform any such testing only in response to the shopper visiting the shopping website. For at least these reasons, Kenney cannot render these claims obvious.

D. The Rejection of Claims 27-35 and 45-47 under 35 U.S.C. § 103(a) Over Kenney in View of Feinleib Is Improper

1. Feinleib

Feinleib is directed to an email-based reminder system. In Feinleib, a message submitter sends an e-mail message containing information specifying a reminder to deliver in the future. (col. 2, lines 50-53.) This information includes a time to send the reminder, the e-mail address of a reminder recipient, and text to include in the reminder. (col. 3, lines 17-30.) When the time specified in the reminder arrives, the central computer sends an e-

mail message containing the specified reminder to the specified message receiver. (col. 4, lines 28-34.)

2. The Examiner Failed to Establish a *Prima Facie* Case of Obviousness

In the third Office Action, the Examiner rejected claims 27-35 and 45-47 under 35 U.S.C. § 103(a) as being obvious over Kenney in view of Feinleib. In the fourth and fifth Office Actions, the Examiner rejected claims 27-35 and 45-47 under 35 U.S.C. § 103(a) as being obvious over Kenney as applied to claims 36-38 and 41-44 above, and further in view of Feinleib. In rejecting the claims, the Examiner states in the third Office Action that:

Kenney teaches all of the limitations of the claims except for the step of scheduling for a time for transmission of a unilateral transmission indicating that the item should be purchased. Feibleib discloses a reminder system that sends email reminders at a specified time prior to an event occurrence. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the reminder system of Feinleib with the invention of Kenney to send timely reminders to users via email, voice mail, or instant message, regardless of whether they are engaged in electronic shopping, to ensure that customers are aware of an upcoming event.

(third Office Action, p. 4.)

The Examiner has failed to establish a *prima facie* case for the obviousness rejection of claims 27-35 and 45-47 over Kenney as applied to claims 36-38 and 41-44 in view of Feinleib, in that the Examiner has failed to show how the teachings from Kenney and Feinleib would have suggested the subject matter claimed in claims 27-35 and 45-47 to a person of ordinary skill in the art.

Claims 27-34 each recite "scheduling for a time preceding the determined expiration time a unilateral transmission of a communication to the purchasing entity indicating that the item should be replenished." Claims 35 and 45-47 each recite "a replenishment proposal subsystem that transmits to the purchaser in advance of the target date determined for the item by the replenishment targeting subsystem, at a time at which the

purchaser is not engaged in an electronic shopping activity, a replenishment proposal to order a replacement for the item." The Examiner has failed to point out where and how the combination of Kenney and Feinleib suggests the cited features of claims 27-35 and 45-47.

According to the Manual of Patent Examining Procedure and controlling case law, the motivation to combine or extend prior art references under 35 U.S.C. § 103(a) cannot be based on mere common knowledge and common sense as to benefits that would result from such combination or modification. Instead, such motivation must be based upon specific teaching in the prior art, such as a specific suggestion in a prior art reference.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Manual of Patent Examining Procedure, § 2143 (emphasis added).

In the fourth Office Action, the Examiner responds to Appellant's argument that there is no motivation to combine the teachings of Kenney and Feinleib and that the Examiner explain with the required specificity where a suggestion or motivation to combine the references in the manner proposed by the Examiner can be found in the prior art, by merely stating:

Examiner merely disagrees. Feinleib discloses a reminder system that notifies users of upcoming events. Examiner maintains that this is sufficient motivation to employ the system of Feinleib to notify users of the need to reorder items.

(fourth Office Action, p. 9.)

In the fifth Office Action, the Examiner again responds to Appellant's argument that there is no motivation to combine Kenney and Feinleib, with the following statement:

In response to applicant's arguments that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

(fifth Office Action, p. 8.)

The Examiner's position that Feinleib's disclosure of a reminder system is sufficient motivation to combine the teachings of Kenney and Feinleib does not satisfy the Examiner's burden to show how Kenney and Feinleib would have suggested scheduling for a time preceding the determined expiration time a unilateral transmission of a communication to the purchasing entity indicating that the item should be replenished, or transmitting to the purchaser in advance of the target date determined for the item by the replenishment targeting subsystem, at a time at which the purchaser is not engaged in an electronic shopping activity, a replenishment proposal to order a replacement for the item, as recited. The Examiner's subsequent statement of recognition quoted above also fails to satisfy the Examiner's burden. Accordingly, the Examiner has failed to satisfy his burden with respect to claims 36-38 and 41-43.

3. There is No Suggestion or Motivation to Combine Kenney and Feinleib, and Kenney and Feinleib are Therefore Incapable of Supporting any Proper Rejection of Claims 27-35 and 45-47 Under 35 U.S.C. § 103(a)

Kenney and Feinleib cannot be combined to disclose or suggest all of the elements recited by claims 27-35 and 45-47. Claims 27-34 recite "scheduling for a time preceding the determined expiration time a unilateral transmission of a communication to the purchasing entity indicating that the item should be replenished." Claims 35 and 45-47

recite "a replenishment proposal subsystem that transmits to the purchaser in advance of the target date determined for the item by the replenishment targeting subsystem, at a time at which the purchaser is not engaged in an electronic shopping activity, a replenishment proposal to order a replacement for the item." The Examiner concedes that Kenney does not teach scheduling for a time for transmission of a unilateral transmission indicating that the item should be purchased. There is no suggestion or motivation to combine Kenney and Feinleib. For at least these reasons, Kenney and Feinleib cannot render these claims obvious.

E. The Rejection of Claims 39 and 40 Under 35 U.S.C. § 103(a) Over Kenney in View of Roden Is Improper

1. Roden

Roden is directed to a method by which a distributor owns, manages and automatically replenishes the inventory of a business that is a customer of the distributor. The customer and the distributor initially agree on certain designated items which are to be owned and managed by the distributor on behalf of the customer. (col. 1, line 66-col. 2, line 1.) In particular, the distributor purchases from the business the inventory of designated items and then invoices the business on a unit of use basis for reimbursement, but only at the time when the designated items are sold to consumers by the business. (See Abstract.)

2. The Examiner Failed to Establish a *Prima Facie* Case of Obviousness

In the fourth and fifth Office Actions, the Examiner rejected claims 39 and 40 under 35 U.S.C. § 103(a) as being obvious over Kenney as applied to claims 36-38 and 41-44 above, and further in view of Roden. In rejecting the claims, the Examiner states in the both Office Actions that:

Kenney teaches all of the limitations of the claims, except for a teaching that the product is automatically ordered. Roden et al disclose [sic] a method for automatically reordering needed inventory (see abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teaching of Manchala et al with the invention of Kenney to ensure that the products are ordered in a timely fashion.

(fourth Office Action, p. 8; fifth Office Action, p. 8.)

Even though the Examiner makes reference to "Manchala" above, Appellant interprets the Examiner's reference to be inadvertent and believes that the Examiner intended to reference "Roden" instead of "Manchala."

The Examiner has failed to establish a *prima facie* case for the obviousness rejection of claims 39 and 40 over Kenney in view of Roden, in that the Examiner has failed to show how the teachings from Kenney and Roden would have suggested the subject matter claimed in claims 39 and 40 to a person of ordinary skill in the art.

Claims 39 and 40 each recite "without intervention by the customer, placing an order on the customer's behalf for replenishment of the item within a predetermined tolerance of the target replenishment date." The Examiner has failed to point out where and how Roden discloses or suggests placing an order on the customer's behalf without intervention by the customer. To the contrary, in Roden, the distributor automatically replenishes the items dispensed to consumers by the business in response to a transaction report electronically transmitted by the business to the distributor. (See Abstract.) The automatic replenishment by the distributor in Roden is NOT without intervention by the business. The Examiner has failed to show how the teachings from Kenney and Roden would have suggested placing an order on the customer's behalf without intervention by the customer.

Accordingly, the Examiner has failed to satisfy his burden with respect to claims 39 and 40.

3. Kenney and Roden Together Fail to Disclose or Suggest All of the Elements Recited by Claims 39 and 40, and are Therefore Incapable of Supporting any Proper Rejection Under 35 U.S.C. § 103(a)

Together, Kenney and Roden fail to disclose or suggest all of the elements recited by claims 39 and 40. Claims 39 and 40 recite "without intervention by the customer, placing an order on the customer's behalf for replenishment of the item within a predetermined tolerance of the target replenishment date." The Examiner concedes that Kenney does not teach that the product is automatically ordered. Roden fails to cure this shortcoming of Kenney. As discussed above, Roden does not disclose or suggest placing an order on the customer's behalf without intervention by the customer. To the contrary, as discussed above, the distributor automatically replenishes the items dispensed to consumers by the business in response to a transaction report electronically transmitted by the business to the distributor. For at least these reasons, Kenney and Roden cannot render these claims obvious.

VIII. SUMMARY

Each of claims 1-47 has been improperly rejected, both (a) in that the Examiner has failed to make a *prima facie* case of unpatentability, and (b) in that the cited references would not support any rejection of these claims. Accordingly, Appellants seek the reversal of the rejection of these claims.

Dated:

7/15/05

Respectfully submitted,

By

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/558,313

1. A method in a data processing system for automatically initiating the replenishment of a consumable product, comprising:

on a first date, fulfilling an order by a consumer for a first instance of the product;

based upon the first date, estimating a second date by which the first instance of the product will be fully consumed;

before the second date, providing to the consumer an indication that the product should be replenished, the indication including a control usable by the consumer to request replenishment of the product by performing a single action;

receiving an indication that the control was used by the consumer to request replenishment of the product; and

in response solely to receiving the indication, ordering a second instance of the product to replenish the first instance.

2. A method in a data processing system for ordering an item, comprising:

on a first date, fulfilling an order by a consumer for a first item;

determining a target date for suggesting replenishment of the first item, the target date based upon the first date and the identity of the first item;

on the target date, providing to the consumer an indication that the first item should be replenished, the indication including a user interface control usable by the consumer to request replenishment of the first item;

receiving an indication that the control was used by the consumer to request replenishment of the first item; and

in response solely to receiving the indication, ordering a second item to replenish the first item.

3. The method of claim 2 wherein the control is usable by the consumer to request replenishment of the first item by performing a single action.
4. The method of claim 2 wherein the second item is a physical article.
5. The method of claim 2 wherein the second item is a data product.
6. The method of claim 2 wherein the second item is a service.
7. The method of claim 2 wherein the target date is determined based on an average life span of the first item.
8. The method of claim 2 wherein the target date is determined based on an expiration date for the first item.
9. The method of claim 2 wherein the target date is determined based on an availability date for the second item.
10. The method of claim 2 wherein the target date is determined based on the length of the intervals between the prior purchases.
11. The method of claim 2 wherein the consumer has made a plurality of prior purchases of a complement of the first item, and wherein the target date is determined based on the length of the intervals between the prior purchases.
12. The method of claim 2 wherein a target date is determined based on the size of the first item.

13. The method of claim 2 wherein the target date is determined based on information provided by the consumer.

14. The method of claim 2 wherein a target date is determined based on information about the consumer's lifestyle.

15. A computer-readable medium whose contents cause a computer system to order an item by:

receiving an indication of an order by a consumer for a first item having a first date;
determining a target date based upon the identity of the first item;
on the target date, providing to the consumer an indication that the first item should
be replenished, the indication including a user interface control usable by the
consumer to request replenishment of the first item;

receiving an indication that the control was used by the consumer to request
replenishment of the first item; and

in response solely to receiving the indication, ordering a second item to replenish
the first item.

16. The computer-readable medium of claim 15 wherein the provided indication includes a control usable by the consumer to request replenishment of the first item, the method further comprising:

receiving an indication that the control was used by the consumer to request
replenishment of the first item; and

in response to receiving the indication, ordering a second item to replenish the first
item.

17. The computer-readable medium of claim 16 wherein the control is usable by
the consumer to request replenishment of the first item by performing a single action.

18. The computer-readable medium of claim 15 wherein the first date is a date on which the order for the first item was placed.

19. The computer-readable medium of claim 15 wherein the first date is a date on which the order for the first item was fulfilled.

20. The computer-readable medium of claim 15 wherein the target date is determined based on an average life span of the first item.

21. The computer-readable medium of claim 15 wherein the target date is determined based on an expiration date for the first item.

22. The computer-readable medium of claim 15 wherein the target date is determined based on an availability date for the second item.

23. The computer-readable medium of claim 15 wherein the consumer has made a plurality of prior purchases of the first item, and wherein the target date is determined based on the length of the intervals between the prior purchases.

24. The computer-readable medium of claim 15 wherein the consumer has made a plurality of prior purchases of a complement of the first item, and wherein the target date is determined based on the length of the intervals between the prior purchases.

25. The computer-readable medium of claim 15 wherein a target date is determined based on the size of the first item.

26. The computer-readable medium of claim 15 wherein the target date is determined based on information provided by the consumer.

27. A method in a data processing system for assessing item replenishment, comprising:

determining that a purchasing entity possesses an item;

determining an expiration time for the item; and

scheduling for a time preceding the determined expiration time a unilateral transmission of a communication to the purchasing entity indicating that the item should be replenished.

28. The method of claim 27, further comprising delivering the communication at the scheduled time.

29. The method of claim 28 wherein the delivered communication contains a control for ordering an additional item to replenish the item.

30. The method of claim 29, further comprising:

receiving an indication that the purchasing entity used the control contained in the delivered communication to order an additional item to replenish the item; and

in response to receiving the indication, ordering an additional item to replenish the item.

31. A computer-readable medium whose contents cause a data processing system to assess item replenishment by:

determining that a purchasing entity is using an item;

determining an expiration time for the item; and

scheduling for a time preceding the determined expiration time a unilateral transmission of a communication to the purchasing entity indicating that the item should be replenished.

32. The computer-readable medium of claim 31, further comprising delivering the communication at the scheduled time.

33. The computer-readable medium of claim 32 wherein the delivered communication contains a control for ordering an additional item to replenish the item.

34. The computer-readable medium of claim 33, further comprising:
receiving an indication that the purchasing entity used the control contained in the delivered communication to order an additional item to replenish the item;
and
in response to receiving the indication, ordering an additional item to replenish the item.

35. A system for automatic item replenishment, comprising:
a replenishment targeting subsystem that, for a particular item purchased by a purchaser on a purchased date, determines a target date for replenishment of the item;
a replenishment proposal subsystem that transmits to the purchaser in advance of the target date determined for the item by the replenishment targeting subsystem, at a time at which the purchaser is not engaged in an electronic shopping activity, a replenishment proposal to order a replacement for the item; and
a replenishment ordering subsystem that orders a replacement for the item responsive to an affirmative response to the replenishment proposal from the purchaser.

36. A computer memory containing an item replenishment data structure, the data structure comprising a plurality of entries, each entry comprising an identification of a consumer, an identification of an item, and an indication of a target date on which the

replenishment of the item is to be proposed, such that, on a current date, for each entry indicating the current date as its target date, a unilateral communication can be transmitted to the consumer identified by the entry proposing the replenishment of the item identified by the entry.

37. The computer memory of claim 36 wherein the item replenishment data structure further comprises, for each of a plurality of dates, an indication of the entries indicating the date as their target date.

38. A generated data signal conveying a item replenishment data structure, the data structure comprising a plurality of entries, each entry comprising an identification of a consumer, an identification of an item, and an indication of a target date on which the replenishment of the item is to be proposed, such that, on a current date, for an entry indicating the current date as its target date, a unilateral communication can be transmitted to the consumer identified by the entry proposing the replenishment of the item identified by the entry.

39. A method in a computer system for automatically replenishing an item, comprising

determining that a consumer is using an item;

determining a target date for replenishing the item; and

without intervention by the consumer, placing an order on the consumer's behalf for replenishment of the item within a predetermined tolerance of the target replenishment date.

40. The method of claim 39 wherein the consumer has made a plurality of prior purchases of the item, and wherein the target replenishment date is determined based on the length of the intervals between the prior purchases.

41. A method in a data processing system for suggesting item replenishment, comprising:

- determining that a purchasing entity is using an item;
- establishing a condition for suggesting replenishment of the item;
- testing the condition;
- when testing indicates that the condition is satisfied, raising an event; and
- when the event is raised, unilaterally suggesting replenishment of the item to the purchasing entity.

42. The method of claim 41 wherein the established condition is a temporal condition.

43. The method of claim 41 wherein the established condition is the availability of a replacement item.

44. The method of claim 1 wherein the control contained in the received indication includes a defined region in which the user may perform a single mouse click in order to request replenishment of the product.

45. The system of claim 35, further comprising an electronic mail transmission subsystem that transmits replenishment proposals as electronic mail messages on behalf of the replenishment proposal subsystem.

46. The system of claim 35, further comprising an instant message transmission subsystem that transmits replenishment proposals as instant messages on behalf of the replenishment proposal subsystem.

47. The system of claim 35, further comprising a voicemail transmission subsystem that transmits replenishment proposals as voicemail messages on behalf of the replenishment proposal subsystem.

EVIDENCE APPENDIX

RELATED PROCEEDINGS APPENDIX